



**Rejections under 35 U.S.C. § 103**

Claims 11, 12 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balachandran in view of U.S. Patent No. 5,347,539 to Sridhar et al. ("Sridhar"). Claims 13 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Balachandran in view of Sridhar and further in view of U.S. Patent No. 6,345,071 to Hamdi. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Balachandran in view of Sridhar, Takatori, Hamdi, and further in view of U.S. Patent No. 5,265,151 to Goldstein. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takatori in view of Balachandran. Applicants respectfully traverse each of these rejections.

As previously set forth above and supported by a Declaration under 37 C.F.R. § 1.131 submitted herewith, Applicants attest that the claimed inventions have an invention date which is earlier than the effective filing date of Balachandran. Therefore, Balachandran does not qualify as prior art under 35 U.S.C. § 102(e) and, hence, Balachandran can not be used in combination with other references to form an obviousness-type rejection under 35 U.S.C. § 103(a). Thus, the Examiner has not met the burden of proving a *prima facie* case of obviousness against claims 11, 12, 13, 17, 18, 20 and 26. Therefore, Applicants request withdrawal of these rejections.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takatori in view of U.S. Patent No. 6,426,961 to Nimmagadda. Amended claim 21 now depends from claim 20, and Applicants submit that claim 20 is patentable for at least the reasons discussed above for claim 20. Withdrawal and reconsideration of the rejection is requested.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takatori in view of Goldstein and further in view of U.S. Patent No. 6,111,9376 to Bremer.

The Examiner acknowledges that the combination of Takatori and Goldstein makes obvious all elements of claim 27 with the exception of the feature of "indicating a need to install an in-line filter if the noise margin does not exceed the threshold." The Examiner contends that Bremer discloses a DSL device that indicates the need to add a phone filter based on a comparison of signal and distortion, citing Bremer at column 9, lines 14-21. The Examiner contends that the combination

of Takatori, Goldstein and Bremer would be obvious to a person of ordinary skill in the art at the time of the invention to achieve the invention of claim 27.

Amended claim 27 now recites the steps of “providing telephone equipment in an on-hook state coupled to the modem; activating the modem; (and) measuring a noise margin.” Support for this amendment can be found in the Specification at page 22, lines 17-18, and Figure 7, item 701, therefore, no new matter is added. Bremer discloses that: “A possible exception that would allow detection would be to measure the distortion component when a telephone signal is silent. This is impractical, however, because there is no guarantee of silence and because the level of distortion to be measured is very small and not dissimilar to the amplitude of signals due to telephone background noise.” (Bremer, column 7, lines 17-24.)

Applicants submit that a telephone signal is silent when the telephone equipment is on-hook. Thus, the invention recited in amended claim 27 achieves what Bremer discloses to be “impractical.” Applicants submit that Bremer teaches away from the present invention and, thus, does not provide the necessary motivation for a person of ordinary skill in the art to combine Bremer with Takatori and Goldstein. Therefore it is impermissible to combine Takatori, Goldstein and Bremer to establish a *prima facie* case of obviousness against amended claim 27. Applicants request withdrawal and reconsideration of the rejection.

#### **Objections to Claims 6-10 and 14-16**

Claims 6-10 and 14-16 are objected to as being dependent upon a rejected base claim.

Claims 6-10 depend from independent claim 1, and claims 14-16 depend from independent claim 11. Independent claims 1 and 11 stand rejected. However, as previously discussed, Applicants attest that the claimed inventions have an invention date which is earlier than the effective filing date of the prior art reference being applied against claims 1 and 11. A declaration to that effect is submitted herewith. Accordingly, Applicants submit that claims 6-10 and 14-16 are in condition for allowance.

## CONCLUSION

Each and every point raised in the Office Action dated June 19, 2003 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-18 and 20-32 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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